

### **REMARKS**

Applicants thank the Examiner for the detailed Office Action dated 1 October 2007. Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

Claims 1-37 were pending in the application. Claims 1-3, 6, 8-10, and 22-37 are requested to be cancelled without prejudice or disclaimer. After amending the claims as set forth above, claims 4-5, 7, and 11-21 are now pending in this application.

For simplicity and clarity purposes in responding to the Office Action, Applicants' remarks are primarily focused on the rejections applied to the independent claim (i.e., claim 4) as outlined in the Office Action with the understanding that the dependent claims are patentable for at least the same reasons (and in most cases other reasons) that the independent claim is patentable. Applicants expressly reserve the right to argue the patentability of the dependent claims separately in any future proceedings.

#### **Objection to the Abstract**

On page 2 of the Office Action, the Examiner objected to the abstract for exceeding 150 words. Applicants have amended the abstract and respectfully request that the objection be withdrawn.

#### **Claim Objections**

On page 3 of the Office Action, claims 6 and 8 were objected to because of a few informalities. Claims 6 and 8 have been canceled. Accordingly, Applicants respectfully request that the rejection be withdrawn.

**Claim Rejections – 35 U.S.C. § 112 ¶2**

On page 3 of the Office Action, claims 8-10 were rejected under 35 U.S.C. § 112 ¶2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 8-10 have been canceled. Accordingly, Applicants respectfully request that the rejection be withdrawn.

**Claim Rejections – 35 U.S.C. § 103(a)****Independent Claim 4**

On pages 3-6 of the Office Action, independent claim 4 and various dependent claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,402,770 to Jessen in view of U.S. Patent No. 6,048,354 to Lawrence. Applicants respectfully traverse the rejection.

Applicants respectfully submit that there is no motivation, teaching, or suggestion to combine the references in the manner asserted in the Office Action. The reason given in the Office Action for combining these two references is that “it would more accurately place the incision at the desired location. However, the device of Jessen is used for “emergency management of upper airway obstructions and chest injuries.” Jessen, abstract. Jessen makes no mention of guidewires being positioned near an upper airway obstruction or a chest injury. In fact, Applicants submit that few patients show up at the emergency room with an upper airway obstruction or a chest injury with a guidewire positioned nearby. Moreover, in such situations there is no time to insert a guidewire.

For these reasons, Applicant respectfully submits that there is no reason to combine the references in the manner asserted by the Patent Office. To the extent the Patent Office disagrees, the Patent Office is required to make particular findings regarding why the skilled artisan, viewing each reference as a whole and with no knowledge of the claimed invention, would have combined them in the manner asserted in the Office Action even though Jessen does not disclose

using a guidewire, nor is it clear how a guidewire would even be helpful to the device of Jessen. If anything, using a guidewire with Jessen would cause delays, which are highly discouraged in emergency situations. See In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (holding that the Patent Office must make “particular findings . . . as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”).

Applicants respectfully submit that the subject matter recited in independent claim 4 and the claims which are dependent thereon, considered as a whole, would not have been obvious to a person of skill in the art and are patentable. Accordingly, Applicants request that the Patent Office withdraw the rejection of these claims under 35 U.S.C. § 103(a).

\* \* \*

Applicants respectfully submit that the present Application is in condition for allowance. Applicants request reconsideration and allowance of the pending claims. The Examiner is invited to contact the undersigned by telephone if the Examiner needs anything or if a telephone interview would advance the prosecution of the present application.

Applicants respectfully put the Patent Office and all others on notice that all arguments, representations, and/or amendments contained herein are only applicable to the present patent application and should not be considered when evaluating any other patent or patent application including any patents or patent applications which claim priority to this patent application and/or any patents or patent applications to which priority is claimed by this patent application.

The Commissioner is hereby authorized to charge any additional fees which may be required for this application, or credit any overpayment, to Deposit Account No. 08-2623. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension and authorize payment of any such extension fees to Deposit Account No. 08-2623.

Respectfully submitted,

Date 1 April 2008

By /Scott C. Nielson/

Scott C. Nielson  
Registration No. 50,755